



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Nole et al.) Confirmation No.: 8733
Serial No.: 10/765,460) Group Art Unit: 3654
Filed: February 11, 2004) Attny Docket No.: ID-D07 CIP
For: COFFEE PRESS) Examiner: Esther O. Okezie

RESPONSE TO REQUIREMENT FOR RESTRICTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is responsive to the Office Action dated July 28, 2005. In that Office Action, the Examiner required restriction to one of the inventions in Group I (claims 1-23) or Group II (claims 24-27).

Applicants provisionally elect Group I (claims 1-23) for prosecution but respectfully traverse the Restriction Requirement and request reconsideration. Applicants further reserve the right to file divisional and/or continuation applications on the subject matter of the non-elected embodiment if the Restriction Requirement is not withdrawn.

This Restriction Requirement should be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §1.141. 35 U.S.C. §121 provides that the Commissioner may restrict an application when "two or more independent and distinct inventions are claimed in a single application." (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction conditioned upon the finding that independent and distinct invention are found within a single application.

Nor is the Restriction Requirement in compliance with the M.P.E.P. It is well established that the Office Action must provide a rationale on the record to support a Restriction Requirement. More specifically, M.P.E.P. §808 states:

The requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct and (2) the reasons for insisting upon restriction therebetween.... (emphasis in original).

Applicants submit that the subject matter in Group I and Group II is so closely related that a search and examination can be conducted without serious burden to the Examiner within the meaning of M.P.E.P. §803. Examination of claims 24-27 in a subsequent divisional or continuation application would require searching the same body of prior art as elected claims 1-23. Given that Groups I and II are directed toward such closely related embodiments, restriction would only serve to create added work and expense for the U.S. Patent and Trademark Office, and inequitably burden the Applicants with unnecessary expenses.

It is noted that the Requirement for Restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142, but is discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made Restriction Requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. See, for example, *Eversharp, Inc. v. Phillip Morris, Inc.*, 356 F.Supp. 778, 150 U.S.P.Q. 98 (E.D.Va. 1966); *aff'd*, 374 F.2d 511, 153 U.S.P.Q. 91 (4th Cir. 1967). Therefore, to promote the interest of both the public, as well as the Applicants, the Restriction Requirement should not be imposed without a specific analysis, which supports conclusions that two or more independent and distinct inventions are indeed claimed in one application.

The courts have also recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as Applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The Court has observed:

We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore describe in the manner required by 35 U.S.C. §112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Applicants thus respectfully request that the Restriction Requirement between Group I and II be reconsidered and withdrawn and that the embodiments in Group I and II be examined together. Nevertheless, since the Applicants have provisionally elected an invention and have

Application Serial No. 10/765,460
Response dated August 25, 2005
Page 3

fully and completely responded to the foregoing Office Action, the present application is now in order for an early action at least on the merits of the elected Group I (claims 1-23).

Respectfully submitted,

August 25, 2005

By:



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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 25, 2005.



Michael A. Hierl